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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,428	10/13/1999	DANIEL F. LYMAN	1923-48641	7415
21874	7590	06/07/2004	EXAMINER	
EDWARDS & ANGELL, LLP			CEGIELNIK, URSZULA M	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	
			3712	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/417,428

**Applicant(s)**LYMAN, DANIEL F. *cd***Examiner**

Urszula M Cegielnik

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The finality of the Office action dated 01 August 2003 has been withdrawn, and prosecution has been reopened.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jorgensen et al.

Jorgensen et al. disclose an amusement and stress relief device formed of a flexible, resilient material consisting of a center portion (the central portion proximate reference numeral 38) with a planar peripheral portion surrounding the center portion (the portion proximate reference numeral 38); the center portion (the central portion proximate reference numeral 38) having a concave first lower surface (the portion below reference numeral 38) and a convex first upper surface (the upper side portion proximate reference numeral 38), the device having two stable equilibrium positions (col. 3, line 9) wherein a first stable equilibrium position comprises the first lower surface having a concave shape (the portion below reference numeral 38) and the first upper surface having a convex shape (the upper side portion proximate reference numeral 38), and a second stable equilibrium position comprises the first upper surface now having a concave shape (the lower side portion proximate reference numeral 38) and the

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first lower surface now having a convex shape (the lower side portion proximate reference numeral 38), (see Figures 1 and 2), whereby the second equilibrium position provides a shape that is the same as a shape of the device in the first equilibrium position (col. 3, lines 6-10) and the device will hold the second equilibrium position until manual manipulation (col. 3, lines 6-10) returns the device to the first equilibrium position.

Jorgensen et al. do not disclose the device having dimensions of a particular range as set forth in claims 2-8; the device being made of a polymeric material as recited in claims 1, 9, and 16; the surfaces having an illustration or different textures as claimed in claims 10-13; the polymeric material being a colored resin as required by claim 17, and scent being added to the material as recited in claim 14.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device with the dimensions of a particular range as set forth in claims 2-8, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Yet still, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device with the particular polymeric material claimed in claims 9 and 16, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Moreover, it is an obvious design choice as to what type of dimensions the device has; what type of material the device is made from; the device having an illustration on its surface; a scent added to the material, and the texture of the surface. On the other hand, it would have been obvious to one of ordinary skill in the art in view of Jorgensen et al. to provide the device in various sizes, textures, colors and scent as claimed for the purpose of making the device more amusing and interesting. It would also have been obvious to modify the device of Jorgensen et al. as set forth immediately above, as an obvious choice of design and for aesthetic reasons.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 703-306-5806. The examiner can normally be reached on Monday through Friday, from 5:30AM - 2:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 703-308-1745. **The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for both regular and After Final communications.**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at 703-306-5648.

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Urszula M. Cegielnik  
Assistant Examiner  
Art Unit 3712



DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
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